

PATENT APPLN. NO. 10/551,031  
RESPONSE UNDER 37 C.F.R. § 1.116

PATENT  
FINAL

REMARKS

Claim 1 has been amended to limit the inorganic filler of the paste composition of the present invention as defined in claim 1 to those recited in claim 2. Claim 11 has been amended to limit the inorganic filler of the dielectric composition of the present invention as defined in claim 11 to those recited in claim 12. Claims 2 and 12 have been canceled.

Claims 1-5, 8-10 and 17 are rejected in the Final Action under 35 U.S.C. § 103(a) as being unpatentable over Kaneko, JP 2002-226675, in view of Matsumura et al., JP 2001-294445 ("Matsumura"). Claims 11-13, 15, 16 and 19 are also rejected in the Final Action under 35 U.S.C. § 103(a) as being unpatentable over Kaneko in view of Matsumura. These are the same rejections that were made in the previous Office Action dated July 6, 2009.

Applicants respectfully submit that claims 1 and 11 as amended are patentable under 35 U.S.C. § 103(a) over the combination of Kaneko and Matsumura because, contrary to the position taken in the Final Action, a person of ordinary skill in the art would not have been properly motivated, or otherwise have had a proper reason, to modify the composition of Kaneko by substituting the barium titanate of Matsumura for the silica of Kaneko.

The invention of Kaneko is an improvement in a composition for

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adhering a semiconductor chip to a resin substrate, where a powdered silica is used as the filler to reduce the stress-strain resulting from the difference in thermal expansion between the semiconductor chip and the sealing resin. The Office, which has the initial burden of supporting a prima facie case of obviousness, has not shown that the different filler of Matsumura would have been expected to perform the same function as the powdered silica in the composition of Kaneko. In this regard, it is noted that the dielectric powders disclosed in Matsumura clearly existed at the time of the Kaneko invention, yet Kaneko chose to limit the filler in its insulating paste to powdered silica. This fact supports a conclusion that Kaneko did not expect other fillers to provide satisfactory results in its insulating paste.

Moreover, as noted above, Kaneko's insulating paste is used for pasting a semiconductor chip on a substrate. A person of ordinary skill in the art would understand that a lower dielectric constant of an insulating layer in a semiconductor is desired. The silica powder of Kaneko's paste has a dielectric constant of about 4. A person of ordinary skill in the art would not have been motivated to substitute the dielectric powders of Matsumura having a high dielectric constant for the silica of Kaneko.

Removal of the 35 U.S.C. § 103(a) grounds of rejection is in

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order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated January 15, 2010, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to Deposit Account No. 111833.

In the event any additional fees are required, please also charge Deposit Account No. 111833.

Respectfully submitted,

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